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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,378	02/10/2005	Timothy J. Philpot	GB02 0130 US	4848
24738 7590 12/21/2007 PHILIPS ELECTRONICS NORTH AMERICA CORPORATION INTELLECTUAL PROPERTY & STANDARDS 370 W. TRIMBLE ROAD MS 91/MG SAN JOSE, CA 95131			EXAMINER SILBERMANN, JOANNE	
			ART UNIT 3611	PAPER NUMBER
			MAIL DATE 12/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/524,378

**Applicant(s)**

PHILPOT, TIMOTHY J.

**Examiner**

Joanne Silbermann

**Art Unit**

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/25/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. A "size corresponding to that of a standard credit card and/or standard business card" is confusing since credit cards and business cards are not the same size. Also, the use of "standard" is considered to be indefinite since this does not adequately describe any particular size or shape.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10, 13-15, 18, 19 and 23, as far as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Perego, EP 1.083,563 A1.
6. Perego discloses holder 2 to which computer readable storage medium 7 is detachably attached, the holder having a planar shape (Figure 1) and a size corresponding to a conventional credit card (column 2 lines 44-46). Based on the size

of the storage medium shown (in Figures 4 and 5 for example) the planar surface of the holder is at least 100% greater than the planar area of the storage medium, as best as the claims can be understood.

7. Regarding claim 15, Perego teaches more than one storage medium on one card (column 5 lines 56-58).

8. Regarding claims 18 and 19, Perego discloses a holder (Figure 4) having an opening the same size as a storage medium 7, the holder including deformable accommodation means 14. Accommodation means 14 include at least one protrusion 14a.

9. Regarding claim 23, the holder includes opening 11 suitable for accommodating a storage medium, the opening being such that when a storage medium is present the planar faces are not entirely covered (one face is uncovered, as shown by Perego in Figure 5) and are parallel and do not protrude from the planar shape of the card.

10. Claims 10 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Helmer et al. US #2,910,793.

11. Helmer et al. disclose holder "A" having a planar shape into which a computer readable storage medium may be attached or encased (Figure 2). The holder defines an opening (Figure 2) and comprises deformable accommodation means, or lips, 10b and 10c (Figure 5) for deforming upon insertion and removal of the displayed object. Each side includes a pair of such lips, one of which is longer than the other (Figure 5). A gap is formed between these lips on each side of the holder. A center of the holder is

the bendable region. The planar faces of the attached or encased object are not entirely covered when held in the holder.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego.

14. Perego does not teach the specific dimensions of the holder, however as best as the claims can be understood, the size of a conventional (as taught by Perego) credit card is 54 mm by 85 mm and a thickness of less than 5 mm.

15. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perego in view of Walker, US #5,533,614.

16. Perego does not teach how the memory units are assembled on the card, however Walker teaches optically read discs attached side-by-side on the same side of a holder. It would have been obvious to one of ordinary skill in the art to attach discs to the holder of Perego in the manner taught by Walker so that more than one disc may be seen at the same time.

17. Regarding claim 17, the holder is "adapted to hold" two small form factor optical discs.

***Response to Arguments***

18. Applicant's arguments filed October 2, 2007 have been fully considered but they are not persuasive.

19. Rejections under 35 U.S.C. 112

20. The use of alternative language in the claims is understood, however MPEP 2173.05(h)II discusses the use of "or" not "and/or". The use of "and/or" indicates that the holder may be the shape and size of a standard credit card and standard business card. The use of "or" in this case makes sense—the size and shape may be that of a credit card or that of a business card. The use of "and" does not—as Applicant is aware, "standard" business cards are not the same size as "standard" credit cards so it is confusing as to how a holder can be the same size as two differently sized items.

21. Regarding the requirement to recite the medium, Applicant is not required to definitely recite the medium in the claims. However such language may render a claim indefinite. MPEP 2173.05(b).

22. The use of the word "standard" is considered indefinite since as the standard size of such card changes in time the meaning of the claim may change. Sources such as Office Depot and Wikipedia only describe the current standard.

23. Art Rejections

24. Claim 10 recites a holder **either** to which a medium can be attached or in which a medium can be encased. Perego teaches a holder to which a medium can be attached and therefore reads on the claim.

25. New claims 18, 19 and 23 have been rejected under Perego as discussed above.

26. New claims 18-23 have been rejected by Helmer et al. as discussed above.

***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

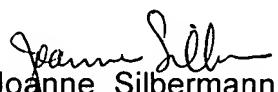
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/524,378  
Art Unit: 3611

Page 7

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Joanne Silberman  
Primary Examiner  
Art Unit 3611

Js  
20 December 2007